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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,249	05/02/2001	Dennis Mendiola	8098.0009	5943

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EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/846,249

Applicant(s)

MENDIOLA ET AL.

Examiner

Yasin M Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1-8.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

- Claims 1-8 are presented for examination.
- Claims 3-5 have been preliminarily amended.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. Also, it is improper method claim [no positively recited method step].

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1,3-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Aravamudan et al USPN (6301609).

As per claim 1, Aravamudan et al teach an instant messaging system (abstract) comprising:

a plurality of clients (clients 142, 144, 150 and 150) having IM client applications of the same or different types;

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an IM server (IM server 130) selectively connected to each of said clients via a computer network (fig. 1) and providing prescribed range of functionality to said clients [col. 4, lines 54 to col. 5, line 14];

each client type having a unique identifier to enable access thereto via said computer network [clients are registered with IM services provider col. 5, lines 2-8 and col.6, lines 45-63]; and

each client having a single account on said IM server for all of its client types that can access said IM server [col.6, lines 32-63];

wherein said account is identified by a unique identification number common to all of the client types of that client [col.6, lines 32-63]; and

wherein each said unique identifier of each client type of a said client is matched to said unique identification number of the particular client [col.7, lines 1-20].

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As per claim 3, Aravamudan et al teach an instant messaging system as claimed in claim 1, wherein said prescribed range of functionality includes:

(i) sending a textual message from one client to another [col. 7, lines 15-33];

(ii) receiving a textual message from one client to another [col. 7, lines 15-33]; and

(ii) identifying which members of a group of clients that a client is a member or prospective member of are currently

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connected to the computer network or are probably so connected [col. 7, lines 15-33].

As per claim 4, Aravamudan et al teach an Instant messaging system as claimed in claim 1, wherein said computer network is the internet of direct electronic link of computers and other electronic devices [fig. 1 and col. 3, lines 28-52].

As per claim 6, Aravamudan et al teach a method for instant messaging (abstract) between a plurality of clients (clients 142, 144, 150 and 150) having IM applications of the same or different types (col. 6, lines 45-63), selectively interconnected to an IM server (IM server 130) by way of a computer network (fig. 1), whereby each client type has a unique Identifier to enable access thereto via the computer network (col.6, lines 32-63), the method comprising the following steps:

providing a single account on the IM server for each client in respect of all of its client types that can access the IM server (col.6, lines 32-63);

identifying the account by a unique identification number that is common to all of the client types of that client [col.6, lines 32-63]; and

matching each unique identifier of each client type of that client to said unique identification number thereof [col.7, lines 1-20].

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As per claim 7, Aravamudan et al teach a instant messaging system substantially as herein described with reference to the accompanying drawings as appropriate [see fig. 1 and 2].

As per claim 8, Aravamudan et al teach a method for instant messaging between a plurality of clients having IM applications of the same or different types substantially as herein described with reference to the accompanying drawings as appropriate [see fig. 1 and 2].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2 and 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al USPN (6301609) in view of McDowell et al US PUB (20010034224).

As per claim 2, Aravamudan et al teach an instant messaging system as claimed in claim 1, wherein said client types include clients connected to the computer network via:



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(i) a Pc-based instant messaging client application program [pc 142];

(ii) a GSM device [wireless cell phone 150];

(iii) an Internet browser-based client application (col. 7, lines 26-33]; or

(iv) an email-based client application [col. 7, lines 26-33].

As per claim 2, although Aravamudan et al shows substantial features of the claimed invention, including wireless devices that receive and send data packets in a wireless network, he does not explicitly show a GSM network.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Aravamudan et al, as evidenced by McDowell et al US Pub. (20010034224).

In analogous art, McDowell et al whose invention is about an instant-messaging system for sharing event information among mobile (wireless) devices, disclose a wireless network using GSM standards [paragraph 14, page 1]. Giving the teaching of McDowell et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Aravamudan et al by employing the system of McDowell et al because it facilitates the sharing of event information such as the presence on a network among mobile users, thereby allowing instant messaging to occur among wireless devices and devices that are on the Internet [paragraphs 0016 and 0028].

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As per claim 5, McDowell et al, as modified, teach the instant messaging system as explained in claim 1, wherein the client types (22, 24 and 28) connected to the computer network via the GSM network (fig. 1) have SMS capability (message can be in the form of a short message on a small screen on the user's cell phone, paragraph 0040) and are initially connected via an SMSC server (SMS server 14, fig.1) to control and manage said SMS there between, and wherein said SMSC server is directly connected to said IM server via said computer network [see fig.1 and paragraphs 0032-0035 page 2].

### Conclusion

5. The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are

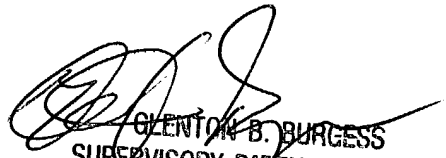
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703-872-9306 for regular communications and 703-746-7238 for  
After Final communications.

Any inquiry of a general nature or relating to the status of  
this application or proceeding should be directed to the  
receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

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